

**Remarks**

Favorable reconsideration of this application, in view of the following remarks and discussion, is respectfully requested.

Claims 1, 4, 6-8, 11, and 13-15 are currently pending in the application.

In the outstanding Office Action Claims 1, 4, 6-8, 11, and 13-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicants' Prior Art Figures 17-21 in view of U.S. Patent No. 2,249,125 to Gabriel, Japanese Publication No. 11-293890 to Katsuyuki, and German Publication No. 33 04 806 to Helfrecht. Applicants respectfully request that the rejection of the claims be withdrawn for the following reasons.

Initially, Applicants express thanks for the courtesies extended by Examiner Phi A to Applicants' representative during a personal interview on November 4, 2004. Applicants respectfully assert that the following points discussed during the interview, with the Interview Summary prepared by Examiner Phi A at the conclusion of the interview, set forth the substance of the interview in accordance with MPEP § 713.04.

The present invention is directed to fastening members (e.g., as recited in independent Claims 1 and 7) as well as siding board attachment structures including the fastening members (e.g., as recited in independent Claims 8 and 14). Independent Claims 1, 7, 8, and 14 recite the fastening member including an upper rising portion having a sloped portion wherein a nail hole which is for piercing through the nail is formed on the sloped portion and a lower abutting portion having a screw hole which is for piercing through the screw, the screw hole formed on one side of a support portion and the nail hole formed on an opposite side of the support portion from the screw hole, the nail hole and the screw hole provided at positions at which a distance from the nail hole to the support portion and a distance from the screw hole to the support portion are substantially equal.

With respect to the rejection of independent Claims 1, 7, 8, and 14, the Office Action explicitly concedes that Applicants' Prior Art Figures 17-21 does not teach or suggest the claimed features of a screw hole formed on one side of a support portion and a nail hole formed on an opposite side of the support portion from the screw hole, the nail hole and the screw hole provided at positions at which a distance from the nail hole to the support portion and a distance from the screw hole to the support portion are substantially equal, as recited in the independent claims.

Further, Applicants respectfully assert that the Office Action does not assert that either Gabriel or Helfrecht teaches or suggests these features recited in independent Claims 1, 7, 8, and 14.

The Office Action relies on Katsuyuki in an attempt to remedy the deficiencies of Applicants' Prior Art Figures 17-21, Gabriel, and Helfrecht. Applicants respectfully assert that Katsuyuki does not remedy these deficiencies, however, for the following reasons.

Katsuyuki is directed to an outer wall material mounting metal fitting. As shown in the figures of Katsuyuki the outer wall bracket 1 includes screw holes 11 and 12.<sup>1</sup>

Applicants respectfully assert that Katsuyuki does not teach or suggest, however, the claimed features of a screw hole formed on one side of a support portion and a nail hole formed on an opposite side of the support portion from the screw hole, the nail hole and the screw hole provided at positions at which a distance from the nail hole to the support portion and a distance from the screw hole to the support portion are substantially equal, as recited in independent Claims 1, 7, 8, and 14. Rather, as stated above, Katsuyuki shows and states two screw holes 11 and 12 (i.e., holes that are perpendicular to a surface to which the outer wall bracket 1 is to be attached, rather than a nail hole which is disposed at an angle to such a surface) on the outer wall bracket 1.

---

<sup>1</sup> Paragraph [0014] of the English language translation.

Applicants respectfully assert that the claimed features recited in independent Claims 1, 7, 8, and 14 can provide numerous advantages that cannot be provided by the references of record, including Katsuyuki. By way of specific non-limiting examples, Applicants respectfully assert that Katsuyuki can provide a single fastening member which can be disposed in a first orientation when the fastening member is desired to be connected to a surface by a nail, and a second orientation when the fastening member is desired to be connected to the surface by a screw. Further, because the screw and nail holes are formed on opposite sides of the support portion, fastening of the upper and lower boards by the fastening member are not affected by the orientation of the fastening member.<sup>2</sup>

Further, inasmuch as one of the screw holes 11 and 12 may be characterized as analogous to the claimed features of a nail hole as recited in independent Claims 1, 7, 8, and 14, Applicants respectfully assert that MPEP § 2143.01 states that “[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves.”

In this case, Applicants respectfully assert that the Office Action has not provided any required teaching, suggestion, or motivation in any of the applied reference to combine Applicants’ Prior Art Figures 17-21, which at most teaches a fastening member including a screw hole and a nail hole on a same side of a support portion such that the fastening member is not reoriented depending on a type of fastener used to secure the fastening member to a surface (but rather maintains a constant orientation regardless of the fastener used), with Katsuyuki which at most teaches a fastening member including two screw holes on opposite sides of a support member having contours such that the fastening member is reoriented only based on relative thicknesses of panels held by the fastening member, to produce the claimed

---

<sup>2</sup> Page 7, line 7 to page 8, line 18, of Applicants’ originally filed specification.

invention of a fastening member that includes a nail hole and a screw hole on opposite sides of a support portion which therefore can be reoriented depending on a type of fastener used to secure the fastening member to a surface.

Thus, Applicants respectfully submit that such a further rejection of independent Claims 1, 7, 8, and 14 would be based on the improper application of hindsight considerations. It is well settled that it is impermissible simply to engage in hindsight reconstruction of the claimed invention, using Applicants' structure as a template and selecting elements from the references to fill in the gaps.<sup>3</sup> Recognizing, after the fact, that a modification of the prior art would provide an improvement or advantage, without suggestion thereof by the prior art, rather than dictating a conclusion of obviousness, is an indication of improper application of hindsight considerations. Simplicity and hindsight are not proper criteria for resolving obviousness.<sup>4</sup> Further, Applicants respectfully assert that the "fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness."<sup>5</sup> Therefore, Applicants respectfully assert that an improper "obvious to try" rationale would be required.<sup>6</sup> Specifically, Applicants respectfully assert that none of the applied references teach or suggest the desirability of the claimed features a fastening member that includes a nail hole and a screw hole on opposite sides of a support portion.

Thus, Applicants respectfully assert that none of Applicants' Prior Art Figures 17-21, Katsuyuki, Gabriel, and Helfrecht teach or suggest the claimed features recited in independent Claims 1, 7, 8, and 14. Therefore, Applicants respectfully request that the rejection of independent Claims 1, 7, 8, and 14 under 35 U.S.C. § 103(a) be withdrawn, and the allowance of Claims 1, 7, 8, and 14.

---

<sup>3</sup> *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

<sup>4</sup> *In re Warner*, 397 F.2d 1011, 154 USPQ 173 (CCPA 1967).

<sup>5</sup> See Heading under MPEP 2143.01.

<sup>6</sup> See MPEP 2145 X.B.

Application No. 09/930,212  
Reply to Office Action of August 10, 2004

Applicants respectfully assert that Claims 4, 6, 11, 13, and 15 are allowable for the same reasons as the independent claims from which they depend, as well as for their own features. Thus, Applicants respectfully request that the rejection of dependent Claims 4, 6, 11, 13, and 15 under 35 U.S.C. § 103(a) be withdrawn, and the allowance of dependent Claims 4, 6, 11, 13, and 15.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 1, 4, 6-8, 11, and 13-15 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact the undersigned representative at the below listed telephone number.

Customer Number

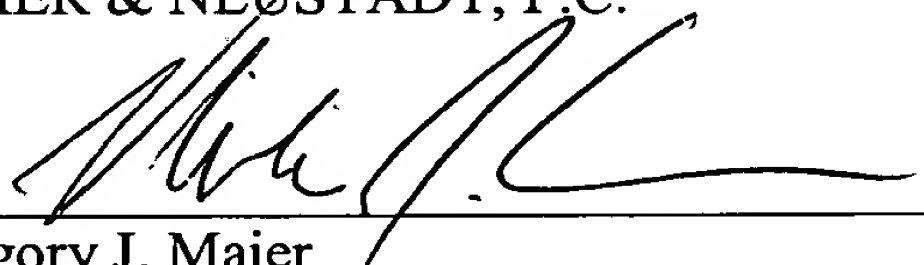
**22850**

Tel: (703) 413-3000  
Fax: (703) 413 -2220  
(OSMMN 06/04)

GJM/PH/me  
I:\ATTY\PH\21S\212905\AMENDMENT\_11082004.DOC

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

  
\_\_\_\_\_  
Gregory J. Maier  
Registration No. 25,599  
Attorney of Record

Philip J. Hoffmann  
Registration No. 46,340